

Docket No.: 265792US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: : EXAMINER: SACKY, EBENEZER O
Katsuaki MIYAJI, ET AL : GROUP ART UNIT: 1624
SERIAL NO.: 10/524,666 : U.S. PATENT NO.: 7,851,503
FILED: FEBRUARY 11, 2005 : ISSUED: DECEMBER 14, 2010
FOR: THROMBOPOETIN RECEPTOR ACTIVATOR AND PROCESS FOR
PRODUCING THE SAME

PETITION UNDER 37 C.F.R. §1.705(d) AND
REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

SIR:

Petitioners hereby request reconsideration of the final patent term adjustment for U.S. Patent No. 7,851,503 (“the ‘503 patent”) of 1116 days determined by the Office. Petitioners submit that the correct patent term adjustment for the ‘503 patent should be 1152 days.

Petitioners contend that the Office erred in determining the final patent term adjustment by improperly subtracting 36 days from the patent term adjustment for the period of November 9, 2010 to December 14, 2010. The Office improperly calculated the period of reduction under 37 CFR 1.704(c)(10) for the filing of the Supplemental Application Data Sheet on November 9, 2010. Correction of the foregoing errors in the patent term adjustment is requested in view of the present Petition including the facts and remarks that follow.

On December 14, 2010, the Office issued the '503 patent. On its face, the '503 patent indicated a final patent term adjustment of 1116 days. The periods of adjustment underlying this 1116-day patent term adjustment determine by the Office were:

- +639 days for the Office's failure to issue an action on the merits within 14 months of the filing of the above-identified application.
- +55 days for the Office's failure to issue an action within 4 months of Applicant's response to the Restriction Requirement filed on February 11, 2008.
- +504 days for the Office's failure to issue the patent within 36 months of the filing of the above-identified application to the first filed RCE on August 24, 2009 (total beyond 36 months of 559 days reduced by 55 days for the overlap between delays under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §154(b)(1)(B)).
- 21 days for the period of delay caused by Applicants ending with the Response to Non-Final Office Action on November 26, 2008.
- 25 days for the period of delay caused by Applicants ending with the Response to Non-Final Office Action on February 1, 2010.
- 36 days for the period from the filing of the Supplemental Application Data Sheet filed on November 9, 2010 to the issuance of the '503 patent on December 14, 2010.

Petitioners submit that the last these adjustments is in error and forms the basis of this Petition.

The Office improperly calculated the period of reduction under 37 CFR 1.704(c)(10) for the filing of the Supplemental Application Data Sheet filed on November 9, 2010 to the issuance of the '503 patent on December 14, 2010.

Petitioners submit that they should be entitled to recuperation of the entire period of November 9, 2010 to December 14, 2010, totaling 36 days since the Supplemental Application Data Sheet filed on November 9, 2010 was to correct an error in the Notice of Allowance.

This filing falls under 37 C.F.R. §1.704(c)(10). In the Office's Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001), the Office stated that the submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" and (7) letters related to government interests (e.g., those between NASA and the Office). (MPEP §2732).

Petitioners submit that the Supplemental Application Data Sheet filed on November 9, 2010, is a "(6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability." In the Declaration and the original specification filed on February 11, 2005, the title of the invention was properly indicated as "Thrombopoietin Receptor Activators and Process for their Production." In the Notice of Allowance mailed on August 9, 2010, the title was indicated as being "Thrombopoietin Receptor Activator and Process for Producing the Same". Thus, to correct the error in the title and to ensure that the title is consistent with the original specification and Declaration, Petitioners filed a Supplemental Application Data Sheet on November 9, 2010. For clarity of the record, the Supplemental Application Data Sheet clearly amended the title to "Thrombopoietin Receptor Activators and Process for their Production."

In view of the foregoing, Petitioners submit the appearance of the incorrect title in the Notice of Allowance constitutes an error or omission in the "Notice of Allowance". Thus, the 36-day reduction in the patent term adjustment for the period of November 9, 2010 to December 14, 2010 is an error.

Petitioners respectfully submit that this Request for Reconsideration of the Patent Term Adjustment of U.S. 7,851,503 should be GRANTED and the patent term adjustment should be recalculated. Petitioners submit that the correct patent term adjustment for the '503 patent should be 1152 days.

In accordance with the provisions of 37 C.F.R. §1.704(b) and (d), Petitioners submit herewith the requisite fee under 37 C.F.R. §1.18(e). In the event that the Office determines that additional fees are required, it is requested that any underpayment be charged to their undersigned Representative's deposit account (Deposit Account No. 15-0030).

Petitioners respectfully request acknowledgment that this Request has been GRANTED and the patent term adjustment has been corrected to properly be indicated as 1152 days. Early notification of such action is earnestly solicited.

Respectfully submitted,
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